

REMARKS

1. *Status of the Application.* Claims 1-63 are cancelled herein without prejudice or disclaimer to the subject matter thereof. Claims 64-178 are added herein. No new matter is added by the addition of these claims.

2. *Correction to the Specification.* The first change to the specification was to insert the cross reference to related applications.

As to the remaining corrections to the specification, a review of the patent application revealed several typographical errors, including an error in the measurement units expressed respecting the diameter of the large ropes shown in Figure 15 of the Application. A person of ordinary skill in the art of the present invention would have recognized the 0.1 “mm” diameter expressed for the large ropes of Figure 15 was incorrect and that such diameter measurement was properly 0.1 μm . The proper dimensional units of the large ropes (also referred to as super-ropes) of Figure 15 is properly reflected in Figure 15 and elsewhere in the Application. For instance, Figure 15 has a scale of 500 nm, and the image of this SEM shows ropes having diameters that measure around 1/5 the length of this scale (*i.e.*, 100 nm, which is 0.1 μm). The Application confirmed that this is the size of what is shown in Figure 15 when it stated “During the ‘roping’ process, this increased mobility enables the formation of ordered ‘super-ropes’ of SWNT which are themselves a fraction of a micronr [*sic*, micron] in dimension as shown in Fig. 15.” Application, at 16, lines 18-20. One tenth of a millimeter is not a fraction of a micron; one-tenth of a micron is.

As further evidence of this, Applicant notes the Application reflects that a SWNT rope 10 nm in diameter contains about 50 single-wall carbon nanotubes. Application, at 14, lines 20-22. The Application notes large ropes made by the process utilized to make the ropes shown in Figure 15 produced super-ropes having approximately 10,000 tubes in cross section. Application, at 15, lines 30-32; *see also*, Application, at 16, lines 10-20. This calculates to a rope having a diameter in the magnitude of 0.1 μm , not 0.1 mm.

3. *New Claims.* In the parent application (United States Patent Application Serial No. 09/890,030, “the ‘030 Application”) to the present Application, the Examiner issued a restriction requirement and identified three groups. Pertinent here, the Examiner stated that for Group I: “Claims 64-147, 160-163, and 193-218 [are] drawn to a method and apparatus of treating a suspension of single-walled carbon nanotubes to an aligning field.” Office Action,

mailed December 19, 2002, in the '030 Application, at 2 ("the '030 Patent Application Office Action").¹ The present Application is a divisional of the '030 Application and is directed to the claims of Group I, *i.e.*, Claims 64-147, 160-163 and 193-219 of the '030 Patent Application.

New Claims 64-147 of the present Application correspond to Claims 64-147, respectively, of the '030 Patent Application.²

As to new Claims 148-151 of the present Application, these correspond to Claims 160-163, respectively, of the '030 Patent Application (with amendments due to changes of dependency).

As to new Claims 152-178 of the present Application, these correspond to Claims 193-219, respectively, of the '030 Patent Application (with amendments due to changes of dependency).

Accordingly, consonance is maintained between the subject matter required to be separated by the Examiner in the '030 Patent Application Office Action restriction requirement and the subject matter claimed in the present Application. *See Texas Instruments, Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1179, 26 U.S.P.Q.2d 1018, 1029 (Fed. Cir. 1993).

It is believed that each of the claims now pending in the present Application recites elements neither taught nor suggested by the prior art. Further, it is believed that the present Application as a whole is in proper form and condition for allowance. If the Examiner believes that the present Application may be placed in even better condition for allowance, he or she is invited to contact the undersigned at the telephone number noted below.

¹In the '030 Patent Application Office Action, the Examiner did not indicate to which group dependent Claim 219 belonged. *See* '030 Patent Application Office Action, at 2. Since Claim 219 depended from Claim 213 (as did Claims 220-218), Applicant understands that, like Claims 213-218, Examiner intended to include Claim 219 within Group I. Accordingly, Applicant will treat Claim 219 by including it within Group I.

² Applicant notes that new Claims 101 and 102 refer to unit lengths measure in μm (rather than mm as previous recited in Claims 101 and 102 of the '030 Patent Application). This change in units dimension is also a correction of the typographical errors found in the Application.

Respectfully submitted,

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